

REMARKS

Introductory remarks

Claims 1-15 were pending before the Office. Applicants have amended claims 1-9 and 11-15. Claim 10 has been cancelled. No claims have been added. Accordingly, claims 1-9 and 11-15 shall be pending upon entry of this Amendment. Reconsideration of the subject application in view of the preceeding amendments and following remarks is respectfully requested.

The amendments have been made solely to claim more fully the invention or to clearly recite what Applicants regard as the invention and/or to expedite prosecution of the present application and should in no way be construed as an acquiescence to any of the Examiner's rejections in the Office action issued in the present application. Applicants reserve the right to pursue claims as originally filed or similar claims in one or more subsequent applications.

Support for the amendments can be found throughout the application, including the specification, examples and claims, as originally filed. No new matter has been added by this amendment.

The Claim Objections Are Overcome

The Examiner objected to claims 1 and 11 due to grammatical and/or typographical informalities. Claim 1 was amended to include periods in the appropriate locations. Claim 11 was amended to correct the spelling of "metallsied" to "metallized." Support for the correct spelling can be found in the specification, for example, at page 12, line 31. No new matter has been added by these amendments.

Applicants respectfully request reconsideration and withdrawal of the objections.

The Claim Rejections Under 35 U.S.C. §112, Second Paragraph, Are Overcome

The Examiner rejected claims 1-15 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Without wishing to acquiesce as to the rejections, each of the claims 1-15 has been amended to clarify the instantly claimed invention or cancelled, thereby overcoming each of the particular bases of rejection under

Section 112 indicated in the Office Action. The Examiner's rejections are addressed individually, as follows.

As to the rejection of claim 1, the claim has been amended to clarify that the potato flour, onion powder and dill powder are those ingredients obtained in the prior steps of the claim. In addition, claim 1 has been amended to clarify that the specified ratios pertain to the amount of each individual ingredient as compared to the total weight of the mixture. Further, the term "said" has been removed.

As to the rejection of claim 5, the step containing the term "enzyme" has been amended to clarify that the heating period inactivates the enzymes present in the potatoes.

As to the rejection of claims 7-10, the claims have been amended to clarify that the recited "peak viscosity, hot paste viscosity and cold paste viscosity" of the soup mix refers to intrinsic properties of the soup mix and are measurable by the methods of the invention. It is believed that this recitation does not lack antecedent basis for the above reasons.

As to the rejection of claim 9, claim 1 has been amended at step (v) such that the dried potatoes are not limited to preclude them being the native potatoes of claim 9.

As to the rejection of claim 10, the rejection is moot because the claim has been cancelled.

As to the rejection of claim 11, the rejection is overcome because the language specifying the thickness of the laminate pouch has been removed.

As to the rejection of claim 12, the rejection is overcome because the term "excellent" has been removed.

As to the rejection of claim 12, the rejection is overcome because the objected to term regarding the mix to water ratio has been removed.

As to the rejection of claims 13 and 15, the rejection is overcome because the objected terms have been removed.

Accordingly, in view of at least the above, Applicants respectfully request reconsideration and withdrawal of the Section 112 rejections.

The Rejections Under 35 U.S.C. §103(a) Are Overcome

Claims 1-3 and 7-14 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Spaeti et al. (US 3987207) in view of Harris et al. (US 5232732) and a Dill Factsheet (NPL Document) and in further view of Murakami (US 6536689) and Willard (US 3535128) taken with the evidence given by Antioxidant Properties of Dry Souo (NPL Document) and Polybags (NPL Document). Applicants note that the Examiner appears to have intended that this rejection also apply to claim 15. While claim 15 is not included with the listing of rejected claims on page 4, the rejection as applied to claim 15 is discussed on page 12. Thus, Applicants will treat this rejection as applying to claims 1-3 and 7-15.

Claim 4 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Spaeti et al. (US 3987207) in view of Harris et al. (US 5232732) and Dill (NPL Document) and in further view of Murakami (US 6536689) and Willard (US 3535128) as applied to claim 3, and in further view of Burrows et al. (US 5084291), Hilton (US 3109739) taken with the evidence given by Borders et al. (US 3220857) and Tschergi (US 3650776).

Claim 5 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Spaeti et al. (US 3987207) in view of Harris et al. (US 5232732) and Dill (NPL Document) and in further view of Murakami (US 6536689), Willard (US 3535128), Burrows et al. (US 5084291), Hilton (US 3109739) taken with the evidence given by Borders et al. (US 3220857) and Tschergi (US 3650776) as applied to claim 4 above, and further in view of Burrows et al. (US 5084291) and Hilton (US 3109739) taken with the evidence given by Borders et al. (US 3220857).

Claim 6 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Spaeti et al. (US 3987207) in view of Harris et al. (US 5232732) and Dill (NPL Document) and in further view of Murakami (US 6536689), Willard (US 3535128), Burrows et al. (US 5084291), Hilton (US 3109739) taken with the evidence given by Borders et al. (US 3220857) and Tschergi (US 3650776) as applied to claim 4 above, and further in view of Prater et al. (US 2957771).

Applicants respectfully disagree with the rejections and traverse as follows.

As the Office will appreciate, *Graham v. John Deere Co.*, 338 U.S. 1, 148 USPQ 459 (1966), was reaffirmed by *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007) as providing the correct analytical framework for determining obviousness. Under *Graham*, obviousness is a question of law based on underlying factual inquires that address (1) the scope and content of the prior art, (2) the differences between the claimed invention and the prior art, and (3) the level of ordinary skill in the pertinent art. *Additionally*, the Supreme Court in *KSR* required a “clear articulation of the reason(s) why the claimed invention would have been obvious” and that such reason “supporting a rejection under 35 U.S.C. 103 should be made explicit.”

Here, the Examiner argues for each rejection that the combination of references is proper because there exists some teaching, suggestion, or motivation in the prior art that would have led the skilled artisan to modify or combine cited prior art to arrive at claimed invention. For the obviousness rejections to be proper, the prior art references or their combination must be shown to ***teach or suggest all the claim limitations***. In *re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). In addition, for the rejection to be proper under the rationale used by the Office, there must be some ***teaching, suggestion or motivation to combine*** the references to achieve the claimed invention, and a finding of a ***reasonable expectation of success***.

Here, the obviousness rejections cannot stand because the prior art cited by the Examiner, taken each alone or in any combination, does not teach or fairly suggest all of the claim limitations. And even if, *arguendo*, all of the claim limitations were taught or suggested by the prior art, which is not being admitted here, the combination of references cited by the Examiner lack a proper teaching, suggestion or motivation to be combined such that the particular claimed features of the inventive process are each met. At best, the Examiner’s combination of the—in total—***nine (9)*** cited references is based on impermissible hindsight reconstruction. Alternatively, the Examiner is applying an improper “obvious to try” rationale to support the combination of references and the obviousness rejection.

As presently claimed, claim 1—to which all other claims directly or indirectly depend—is directed to a specifically recited process for making an instant soup mix containing Indian dill. The process involves **cutting** cleaned Indian dill leaves into shreds of 4-5 cm long; **soaking** the dill leaf shreds in a solution containing 0.5 to 1.0 % sodium bicarbonate for a period of 20 to 40 minutes; **drying** the soaked dill leaf shreds using hot air at a temperature in the range of 40°-50°C; **powdering** the dried dill leaf shreds and passing through sieve with a pore size of about 400 to 600 µm to obtain dill powder; **powdering** dried potatoes and dried onions and passing through a sieve to obtain a potato flour and onion powder; **mixing** skim milk powder : Corn flour : the potato flour obtained above : wheat flour : malto dextrin : fat : the dill powder obtained above : salt : sugar : the onion powder obtained above : pepper with a ratio in the range of 10-20 : 12-15 : 10-12 : 10- 14 : 10-14 : 3-8 : 3-6 : 3-5 : 3-7 : 2-4 : 1-2.5 (weight of individual component / total weight of mix), respectively, to obtain a soup mix; and **drying** the soup mix until the moisture content of the mix becomes at least 3 to 5%, thereby obtaining the instant soup mix.

The Examiner contends that Spaeti et al. relates generally to a process for making a dry, granular instant soup mix and that it particularly discloses certain aspects of the claimed method, including a process of making an instant soup mix that includes some, but not all, and not in each of the recited amounts, of the claimed ingredients of claim 1. In particular, the Office Action states that Spaeti et al. teaches an instant soup mix that includes dry milk powder, corn flour, potato flour, wheat flour, chicken fat, salt, sugar and onion powder, which is then pulverized through a sieve. The Examiner admits, however, that Spaeti et al. fails to teach the recited amounts of some of the ingredients, including the corn flour, potato flour, salt, and onion powder. In addition, the Examiner admits that Spaeti et al. does not even disclose maltodextrin or the dill powder of the instantly claimed soup mix or that the soup mix should have a final moisture content of 3-5%. Thus, by the Examiner's own admission, Spaeti et al. fails to teach or suggest all of the recited ingredients (e.g., no teaching of maltodextrin or dill powder) and in their correctly recited amounts. Moreover, as admitted by the Examiner, Spaeti et al. fails to teach or suggest the preparatory steps recited in claim 1, including steps (i) to (iv) and (vi).

The Examiner then turns to Harris et al. for the purported teachings of a dry soup mix that contains maltodextrin and a mixture of herbs and spices. However, Harris et al. does not teach or suggest a dry soup mix that contains dill, nor does Harris et al. teach or suggest any of the specifically claimed amounts of the recited ingredients of claim 1 in the claimed mixture combination. Moreover, as admitted by the Examiner, Harris et al. fails to teach or suggest the preparatory steps recited in claim 1, including steps (i) to (iv) and (vi).

The Dill Factsheet is then relied on by the Examiner for the purported teaching that dill can generally be used in soups. The Dill Factsheet, however, does not teach or suggest any of the other claimed ingredients, nor does it teach or suggest the specific amounts that are used in combination in the claimed soup mixture. Moreover, like with Spaeti et al. and Harris et al., the Dill Factsheet does not teach or suggest any of the preparatory steps recited in claim 1, including steps (i) to (iv) and (vi).

The Examiner must then turn to two additional references in Murakami et al. and Willard et al. to attempt to establish that those claimed features not taught by the combination of Spaeti et al., Harris et al., and the Dill Factsheet are shown elsewhere in the prior art. Specifically, Murakami et al. is cited for its teachings pertaining to a method of manufacturing mulberry leaf powder—not dill powder—by soaking the leaves in sodium bicarbonate and then drying and pulverizing the leaves. However, as admitted by the Examiner, Murakami et al. fails to teach or suggest the specifically claimed composition of the sodium bicarbonate, or the particular amount of soaking time (20-40 minutes), or the particular temperature (40-50 degrees C) used by the invention. Willard et al. is then apparently cited to show that the dried potatoes of step (v) would have been known in the prior art.

Applicants respectfully submit that not only are each of the claimed limitations not met by the prior art—as admitted by the Examiner—the combination of references is clearly improper as being made entirely using hindsight reconstruction. Even if, *arguendo*, all of the elements of the claimed invention were considered to be present in some combination of the cited prior art, there does not exist any motivation to combine these references in the first

instance, nor does there exist any reasonable expectation of success that the claimed invention could be carried out by their combination.

Both the suggestion and the expectation of success must be found in the prior art, not the applicant's disclosure. *In re Dow Chemical*, 5 USPQ 2d 1531 (Fed. Cir. 1988).

One of the more recent Federal Circuit decisions addressing the use of the teaching, suggestion, motivation test post-*KSR* is *Ortho-McNeil Pharmaceutical v. Mylan Labs* (Fed. Cir. 2008). The Court indicated that the *KSR* decision, which arguably limited reliance on the teaching, suggestion, motivation test, is applicable to a limited set of circumstances in which the **art is predictable** and there are **a finite number of options**. The Federal Circuit reasoned that *KSR* relates to the situation where a *finite, and in the context of the art, small or easily traversed, number of options* that would convince an ordinarily skilled artisan of obviousness and that the teaching, suggestion, motivation test remains “the primary guarantor against a non-statutory hindsight analysis.”

Applicants’ claimed invention derives in part from Applicants’ discovery and creation of a new and useful soup mix based on Indian dill that “is an instant, low viscous product with good anti-oxidant properties. It is a free-flowing, convenience product prepared by virtue of this invention using sabsige, modified potato flour, maltodextrin and other ingredients. The process also includes mixing of dry ingredients to maintain low moisture followed by finish drying to bring down the moisture of soup mix further to 5%.” As reflected in claim 1, the particularly claimed process for making the claimed soup mixture is highly specific, involves a highly specific combination of ingredients in a highly specific ratio of amounts, and involves highly specific preparatory steps, which together are not taught or fairly suggested by the cited prior art—either each considered alone or in combination. The fact that individual elements present in Applicants’ claims may also be present in some combination in the cited art is not sufficient to establish *prima facie* obviousness.

The claimed invention **cannot** be assembled by picking and choosing elements from the prior art using the patentee’s claim as a “blue print.” There must be some **motivation** for the combination **other than the hindsight obtained from the invention itself**. See

Interconnect 774 F.2d 1132, at 1143 (*Fed Cir.* 1985). The present rejection is the result of hindsight reconstruction of the invention based solely on Applicants' teachings. By stringing together of a multitude of references—9 in total—the Examiner has hand picked and chosen specific teachings from the references that are based entirely on paralleling the claimed invention in order to assemble a collection of parts that tries to render the claimed invention obvious. One of ordinary skill in the art, armed with the cited references at the time of the invention, simply would not have been motivated—or would not have possessed any reasonable expectation of success in achieving the invention—to reach the invention as presently claimed.

To conclude, as the Office has done, that 9 cited prior art references somehow render obvious the claimed method steps of the invention is, at best, based on an impermissible “obvious to try” standard of obviousness under *KSR Int'l v. Teleflex, Inc.*, 550 U.S. 398 (2007), as reflected in the recent decision in *In re Kubin*, 561 F.3d 1351 (Fed. Cir. 2009). In *Kubin*, the Federal Circuit held that “obvious to try” cannot equate obviousness where the thing that would have been “obvious to try” *would involve trying various adjustable parameters until the desired claimed result is achieved, in the absence of any direction as to which parameters are critical or suggestion as to how they should be adjusted*. In *re Kubin* states that the inverse of this holding was provided in *KSR*, which held that where a skilled artisan merely pursues “known options” from a “finite number of identified, predictable solutions,” obviousness under 103 arises.

Here, one of ordinary skill in the art, armed with the 9 cited references at the time of the invention, would have been faced with various teachings regarding soup mixes that related to a large number of **numerous adjustable parameters**, such as thousands of different specific ingredients (e.g., different herbs, spices, vegetable, flavorings, salts, sugars, etc.) named in the prior art and/or generally available in the art, the specific preparations or treatments of those ingredients that may be carried out, and the thousands upon thousands of specific and different combinations of those ingredients that could be prepared—and in what amounts. There are no teachings, suggestions, motivations or specific guidance contained in any of the cited prior art or in the routine skill cited by

Examiner—but for the specific guidance laid out in Applicants’ specification and claims—that would have provided a way as to how to achieve the specifically claimed soup mix or process for preparing same. There is simply no guidance whatsoever that indicates which ingredients should be combined together, in what amounts, and the importance of one ingredient over the other as to the resultant claimed soup mix.

Accordingly, Applicants respectfully submit in view of the above that a conclusion of obviousness in this instance could only be made using improper hindsight reconstruction and/or on the basis of an impermissible “obvious to try” standard.

All of the claims depend directly or indirectly from claim 1. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Because claim 1 is nonobvious for at least the above reasons, claims 2-9 and 11-15 should also be viewed as nonobvious.

In view of at least the above reasons, Applicants respectfully submit that present Section 103 rejections should be overcome. Accordingly, Applicants respectfully request reconsideration and withdrawal of the above rejections of claims under 35 U.S.C. §103(a) as allegedly being obvious over any of the cited references, taken alone or in any combination.

CONCLUSION

In view of the foregoing, reconsideration and withdrawal of all rejections, and an indication of allowability of the instantly claimed invention are earnestly solicited. If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call Applicants' attorney at the telephone number below.

Applicants believe that there are no additional fees due with this response. However, if a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 04-1105, Order No. 65837(50152), for any additionally required fee(s) due with this response.

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